

add references to the patent applications (now patents) from which the '522 patent claimed priority.²

U.S. Serial No. 09/107,031 from which the '522 patent issued was copending with the present application. In particular, the present application was filed in the Patent Office on September 29, 2000, which was before the November 21, 2000 issuance of the '522 patent. It should also be noted that the '522 patent and the present application have a named inventor in common: Allan E. Alcorn.

It is submitted that the present application is properly describable as a continuation-in-part of the '522 patent. In that regard, Section 201.08 of the M.P.E.P. states that "A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and *adding matter not disclosed* in the said earlier nonprovisional application" (italics original). See also Transco Products Inc. v. Performance Contracting, 32 U.S.P.Q.2d 1077, 1080 (Fed. Cir. 1994)(underlining added), which states:

A 'CIP' application is a continuing application containing a portion or all of the disclosure of an earlier application together with added matter not present in that earlier application.

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The PTO has noted that the expressions 'continuation,' 'divisional,' and 'continuation-in-part' are merely terms used for administrative convenience. ... [T]he bottom line is that, no matter what term is used to describe a continuing application, that application is entitled to the benefit of the filing date of an earlier application only as to common subject matter.

The present application includes subject matter that is not disclosed in the '522 patent. For example, the '522 patent does not disclose the particular housing structure of the gaming machine shown in Fig. 1 of the present application. Also, the present application and the '522 patent disclose common subject matter in that they both disclose a casino-type gaming machine that includes, among other things, a microprocessor, an operating system, a nonvolatile

² Copies of the three patents referred to in the above amendment were enclosed with the information disclosure statement mailed August 30, 2001 and are thus of record in this case.

random-access memory (RAM), a read-only memory (ROM), a sound system, a video system, a disk storage system, authentication of data using a HASH function to generate a message digest, encryption of the message digest using a key, decryption of the message digest using a key, etc.³

It should also be noted that the present application states: "As described in detail in the above-referenced U.S. Patent Application Serial No. 08/497,662, before software can be loaded from the hard disk, it must be verified as being an authentic proprietary product." See paragraph [37] of the substitute specification filed with the amendment mailed August 30, 2001. Application Serial No. 08/497,662 referred to in the above sentence is the application from which U.S. Patent No. 5,643,086 issued, and the '522 patent contains all or substantially all of the disclosure of the '086 patent. For example, Figs. 1-5 of the '522 patent are the same or substantially the same as Figs. 1-5 of the '086 patent.

It is respectfully submitted that the above amendment to the specification identifying the present application as a continuation-in-part of the '522 patent does not require the execution and filing of an additional inventors' declaration by either of the two named inventors of the present application.

³ Exemplary locations where the disclosure of these items may be found in both the '522 patent and the present application (references are to substitute specification filed August 30, 2001) are set forth below:

<u>Item</u>	<u>Present Application</u>	<u>'522 Patent</u>
microprocessor	Page 6, line 15	Fig. 1 (#12)
operating system	Page 7, line 16	Col. 4, lines 19-20
nonvolatile RAM	Page 7, line 1	Col. 7, line 10
ROM	Page 8, line 21	Fig. 1 (#14)
sound system	Page 6, lines 13-14	Fig. 1 (#23)
video subsystem	Page 6, line 12	Fig. 1 (#22)
disk storage system	Page 6, lines 12-13	Fig. 1 (#18, 19)
authentication using HASH function to generate message digest	Page 8, lines 14-26	Col. 4, lines 26-34
encryption of message digest using a key	Page 8, lines 16-17	Col. 8, lines 47-50
decryption of message digest using a key	Page 8, lines 18-23	Col. 9, lines 6-7

In the usual case, a parent application is filed and then a later CIP of the parent is filed that includes subject matter not disclosed in the parent. In that case, an inventors' declaration is required for the CIP since it is a requirement that the inventors must acknowledge the duty of disclosure relative to the new subject matter disclosed in the CIP (as noted by the Examiner in the Advisory Action mailed January 6, 2000 in the parent, U.S. Serial No. 08/864,700, of the present application). See also Section 602.05(a) of the M.P.E.P., which states:

If the examiner determines that the continuation or divisional application contains new matter relative to the prior application, the examiner should so notify the applicant in the next Office Action. The examiner should also (1) require a new oath or declaration along with the surcharge set forth in 37 CFR 1.16(e); and (2) indicate that the application should be redesignated as a continuation-in-part.

In the present case, the above amendment to the specification recites that the present application is a continuation-in-part of the '522 patent. Therefore, the present application contains new subject matter vis-a-vis the '522 patent. However, the inventors' declaration that has been filed with the Office in this case already covers any new subject matter of the present application vis-a-vis the '522 patent because that declaration covers all subject matter disclosed in the present application.

Nevertheless, in the event that the Examiner believes that a new inventors' declaration is required, or if there is any matter that the Examiner would like to discuss, he is respectfully invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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